

**REMARKS**

Reconsideration is respectfully requested.

Claims 1 through 26 remain in this application. No claims have been cancelled, withdrawn, or added.

Claims 1 through 26 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Sands in view of Scheuring.

Claim 1 requires, in part, "scheduling means, disposed within the first device, for enabling scheduling by the user of a call-back based on the identifying caller information identified by said identifying means"

It is contended in the final Office Action, as in the earlier Actions, that Sands teaches a caller ID unit for identifying caller information associated with an incoming call (citing Sands, Figure 5), but it is conceded that:

With respect to the caller ID means it would have been obvious to one of ordinary skill in the art to have incorporated the caller ID device into the phone 12 as such only entail putting two separate devices used together and incorporating them into one device.

It is then asserted that:

With further respect to the scheduling means and the limitations of claims 4, 14, 19 and 22 - 23, note Fig. 1 of Scheuring et al. and paragraphs 0077 and 0078 of Scheuring et al.

And it is alleged that:

It would have been obvious to one of ordinary skill in the art to have incorporated such a scheduling means as taught by Scheuring et al. into the Sands system as such would only entail the substitution of one scheduling means for another. With respect to claim 3, note Fig. 1 of Sands.

With respect to the allegation that it would have been obvious to one of ordinary skill in the art to incorporate the caller ID unit into the phone

12 as such would only entail putting two separate devices used together and incorporating them into one device.

Contrary to the Office Action, it is respectfully submitted that it would not have been obvious to one of ordinary skill in the art to combine the dynamic call waiting phone system of Sands into a telephone. Sands is directed to a telephone system comprising a dynamic call waiting system based on caller ID in which calls are routed based on the calling number, and are, for example, routed to voicemail, a forwarding number or scheduled for a call back (Sands, Abstract).

More specifically, it was previously noted that the Sands patent in actuality clearly teaches one of ordinary skill in the art that the caller ID unit of the Sands system is separate from the telephone, and thus it is submitted that such an allegedly obvious modification of Sands is contrary to the teaching of Sands. For example, Figures 1 and 2 of the Sands patent clearly and unambiguously show the "caller ID unit" 22 (in Figure 1) and 60 (in Figure 2) as a separate and distinct element from the telephone 20 (in Figure 1) and 52 (in Figure 5). It is submitted that there is a clear delineation between these elements in the drawings figures that one of ordinary skill in the art would recognize are distinct elements. (Also note that the telephone 20 and 52 are depicted with a drawing of a telephone, and not simply as another block in the block diagram of these figures, which further leads one of ordinary skill in the art to understand that telephone 20 and 52 is not just simply another element of the overall invention, but a distinct environmental element.)

Further, Sands states at col. 1, lines 56 through 59 that (emphasis added):

Dynamic call waiting based on the caller's ID is carried out under the control of a microprocessor located either in a subscriber's caller ID unit or at a telephone network processing center.

Thus, the Sands patent describes the functionality being carried out by a microprocessor in two locations—neither being in the user's telephone.

Also, Sands states at col. 2, lines 55 through 58:

Caller ID unit 22 is a remote device located with the first telephone terminal 12, commonly referred to as customer premises equipment (CPE).

Thus, the caller ID unit of Sands is described as being used with "customer premises equipment", and not as part of any customer premises equipment or telephone terminal. Still further, Sands describes the caller ID unit at col. 3, lines 7 through 53 as having a number of elements (e.g., speaker) that duplicate those found in a telephone, and describe features (e.g., voice recognition) that are not typically found in a conventional telephone. Thus, it is submitted that these teachings of the Sands patent cannot be ignored so that it can be said that Sands is "unclear" as to whether the caller ID unit is part of a telephone, as the question is what would one of ordinary skill in the art understand from the art.

It is submitted that the allegedly obvious combination of a caller ID unit and a telephone is not an obvious modification of the Sands system. Sands describes a system whose functions go beyond merely providing caller ID information to the user of the telephone, and includes a number of functions in addition to conventional "caller ID". Specifically, the disclosed dynamic call waiting system functions to route calls while a user is using a telephone. It is submitted Sands fails to provide any enabling disclosure which would allow one of ordinary skill in the art to modify a telephone so that the telephone would function as a telephone for carrying on a telephone conversation as well as to function to re-route incoming telephone calls in accordance with the disclosed dynamic call waiting system which is incorporated in a telephone network, i.e., dynamic call waiting system 10, remote from a telephone connected to the system. Since Sands fails to enable one of ordinary skill in the art to produce the present invention as claimed in claim 1 which recites, *inter alia*, scheduling means

disposed in a first device which enables one to speak to an initiator of an incoming call, and schedule, by the user, a call back based on an identified caller information, claim 1 is not obvious in view of Sands.

With respect to the Scheuring patent application publication, and the assertion in the rejection that incorporating the “scheduling means as taught by Scheuring et al. into the Sands system as such would only entail the substitution of one scheduling means for another”, it is submitted that the switch of the elements in the Scheuring system for the elements in the Sands system is not merely “substituting one scheduling means for another”. It is noted that the Sands patent states at col. 6, lines 46 through 54 that (emphasis added):

If at step 156, it is determined not to provide a busy tone to the calling party, the program proceeds to step 160 to determine if a call back service is to be provided when the called party is available. If at step 160 it is determined to provide the call back service, the service provider at step 162 schedules a call back to the called party when the called party's line is no longer busy. The call waiting call is then ended at step 154.

Thus, the Sands system includes an element that schedules a call back that is scheduled when the “called party’s line is no longer busy” (e.g., becomes available). Since the program cannot know how soon or at what point the line will become free, this “scheduling” cannot comprise a specific time, but is keyed to the event that the called party’s line is no longer busy. In contrast, the Scheuring patent application discusses a system in which the caller is provided with the option of choosing a specific time for a call back depending upon “scheduled events” in the user’s calendar, and thus is based upon constraints of the called party’s schedule, but not necessarily when the called party’s line is no longer busy. See, e.g., Scheuring at ¶0078, which states:

[0078] If it is determined (480) to give the caller an option to schedule a callback based on time shown for the caller in the user's portrait database 132 and the user's availability based on scheduled events in the user's calendar, scheduling information is received (490)

from the caller via touchtone input or voice recognition and then the calendar database 117 is updated (495). In addition, the caller may also leave a voicemail. If the caller is not given the option to schedule a callback, the caller may leave a voicemail, which is recorded (485) and stored in stored voicemails 139. The method 400 then ends.

Thus, the Scheuring system is submitted to take a significantly different approach to scheduling the callback, relying instead on the user's schedule to set a time for a callback, rather than simply scheduling a callback for when the called party's line is free, as in Sands.

It is therefore submitted that the allegedly obvious modification of the Sands system with the Scheuring system is not merely "substituting one scheduling means for another", as asserted in the rejection of the Office Action. Thus, it is believed that the cited patents, and especially the allegedly obvious combination of Sands and Scheuring set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1, 10 and 15. Further, claims 2 through 7 and 21 through 24, which depend from claim 1, claims 11 through 14 and 25 and 26, which depend from claim 10, and claims 16 through 20, which depend from claim 15, also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Further, claim 10 requires, in part "providing the caller information associated with the incoming telephone call through the first device to a recipient of the incoming call" and "enabling the recipient of the incoming call to optionally select, *after receiving the incoming call*, initiation of automatic scheduling of a call-back for the incoming telephone call, using the first device, *based on the caller information provided to the recipient*". Further, claim 15 requires, in part, "means for presenting the identifying information to a recipient of the incoming communication" and "means for enabling the recipient of the incoming communication to optionally select, *after receiving the incoming communication and presentation of the identifying information*, initiation of automatic scheduling of a response to

the incoming communication *based on information identified by said identifying means*". Claim 22 requires "wherein the scheduling means enables a user of the portable device, after receiving the incoming call, to, at the option of the user, automatically schedule a call-back". Claim 23 requires "wherein the scheduling means enables a user of the first device, to, at the option of the user and based on a selection by the user after receiving the incoming call, automatically schedule a call-back". None of these requirements were specifically addressed in the rejection of the Office Action, and it is submitted that the allegedly obvious combination of Sands and Scheuring would not lead one of ordinary skill in the art to these requirements

More specifically, and in contrast to the present invention in which, after receiving a telephone call, the user can select to schedule a call back, Sands discloses a call waiting system in which a scheduled call back is stored, i.e., selected, prior to receiving a telephone call. In other words, a user of the Sands system can select to activate a call back feature prior to receiving a telephone call but not after. Further, in Sands, it is the dynamic caller ID system, illustrated, for example by step 160, which determines if a call back service is to be used when the called party is unavailable. If so, the service provider, at step 160, schedules a call back to the called party when the called parties line is no longer busy (Sands, col. 6, lines 46-53 and Figure 6). Therefore, it is the phone system in Sands which does the initiation of automatic call back based on a previous instruction of a user prior to a call being initiated.

Conversely, in the present invention as claimed in claim 23, the user makes the selection to schedule the call back after receiving the phone call, not prior to receiving the phone call. For the foregoing reasons it is respectfully submitted that, Sands does not teach or suggest claim 23.

With regard to claims 10 through 13 and 15 through 18 and 23, as well as added claims 24 through 26, the claims require that the recipient of an incoming communication optionally selects, after receiving an incoming call, to initiate automatic scheduling of a response. As discussed above with regard to claim 23, Sands fails to teach or suggest an arrangement wherein a recipient, after receiving an incoming communication, selects and initiates automatic scheduling of a response. Instead, Sands merely teaches that a recipient, prior to receiving an incoming call, sets up an automatic call back feature. Nowhere does Sands teach or suggest a user selecting, after receiving an incoming call, initiation of automatic scheduling as claimed. Moreover, it is respectfully submitted that Sands does not teach or suggest that a recipient of a call would or could make any determination with respect to, or provide initiation of, automatic scheduling of a call back by the recipient in response to an incoming call. Sands merely teaches an automated system which may schedule a call back if a recipient, prior to receiving an incoming call, has configured the system accordingly.

It is submitted that the aforescribed distinction between the requirements of the claims and the teaching of Sands is significant, as the Sands system is operative only with respect to phone numbers previously entered in the database and previously indicated as being

Withdrawal of the §103(a) rejection of claims 1 through 26 is therefore respectfully requested.

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**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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